

Appl. No. 10/026,123

Response dated February 21, 2004

Remarks

Claims 1-23 are pending in the instant application. In the Final Office Action mailed February 24, 2004, the Examiner rejects claims 1-23. Based on the remarks made herein, Applicants respectfully request that the rejections be withdrawn and that the application be passed to allowance.

1. Paragraph 2 of the Final Office Action Mailed February 24, 2004: Rejection Under 35 U.S.C. §103(a)

In the Final Office Action mailed February 24, 2004, the Examiner renews the rejection of claims 1-3, 5, 7, 11-14 and 20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,779,831 issued to Schmitz (hereinafter "the Schmitz patent") in view of U.S. Patent No. 6,210,388 issued to Widlund et al. (hereinafter "the Widlund patent"). The Examiner reiterates the arguments made in paragraph 2 of the Office Action mailed November 5, 2003.

Applicants maintain that a *prima facie* case of obviousness has not been established. Applicants maintain their assertion that the methods described in the Schmitz patent and the Widlund patent are not compatible with each other and therefore, the method of the Widlund patent cannot be integrated with the method of the Schmitz patent. Applicants reiterate the arguments made in the Response submitted on February 4, 2004.

2. Paragraph 3 of the Final Office Action Mailed February 24, 2004: Rejection Under 35 U.S.C. §103(a)

In the Final Office Action mailed February 24, 2004, the Examiner rejects claims 4, 8 and 15-18 under 35 U.S.C. §103(a) as being unpatentable over the Schmitz patent in view of the Widlund patent as applied to claims 3 and 14 and further in view of International Application Number PCT/US99/29704 having inventors, Fletcher et al. (hereinafter "the Fletcher application"). The Examiner reiterates the arguments made in paragraph 3 of the Office Action mailed November 5, 2003.

Applicants maintain their assertion that the Examiner is relying on impermissible hindsight facilitated by the present application to contend that the combination is obvious. Applicants reiterate the arguments made in the Response submitted on February 4, 2004.

3. Paragraph 4 of the Final Office Action Mailed February 24, 2004: Rejection Under 35 U.S.C. §103(a)

In the Final Office Action mailed February 24, 2004, the Examiner rejects claims 6 and 19 under 35 U.S.C. §103(a) as being unpatentable over the Schmitz patent in view of the Widlund patent as applied to claims 3 and 14 and further in view of U.S. Patent No. 5,399,219 issued to Roessler et al.

Appl. No. 10/026,123

Response dated February 21, 2004

(hereinafter "the Roessler patent"). The Examiner reiterates the arguments made in paragraph 4 of the Office Action mailed November 5, 2003.

Applicants maintain that a *prima facie* case of obviousness has not been established. Applicants reiterate the arguments made in the Response submitted on February 4, 2004.

4. Paragraph 5 of the Final Office Action Mailed February 24, 2004: Rejection Under 35 U.S.C. §103(a)

In the Final Office Action mailed February 24, 2004, the Examiner rejects claims 9, 10 and 21-23 under 35 U.S.C. §103(a) as being unpatentable over the Schmitz patent in view of the Widlund patent as applied to claims 3 and 14 and further in view of GB 2,303,045 issued to Johansson et al. (hereinafter "the Johansson patent"). The Examiner reiterates the arguments made in paragraph 5 of the Office Action mailed November 5, 2003.

Applicants maintain that a *prima facie* case of obviousness has not been established. Applicants reiterate the arguments made in the Response submitted on February 4, 2004.

5. Paragraph 6 of the Final Office Action Mailed February 24, 2004: Response to Arguments

In the Final Office Action mailed February 24, 2004, the Examiner responds to the remarks made in Applicants' Response submitted on February 4, 2004. The Examiner believes the Schmitz patent and the Widlund patent are considered compatible since they both address methods of manufacturing pants-type diapers. The Examiner also believes that although the specific methods are different, one in the art would be motivated to precondition a web to include hook and loop refastening surfaces before cutting as disclosed in the Widlund patent, since by disclosing this feature, the Widlund patent shows it is well known in the art to do so. Further, the Examiner believes one would also be motivated to precondition the web as an alternative to placing the hook and loop refastening surfaces after cutting.

Applicants continue to believe that the Schmitz patent and the Widlund patent are not compatible. The Examiner has provided no basis for motivation or suggestion in the references to combine their teachings and the Examiner does not state how one of skill in the art would know to integrate steps of incongruous methods. The Examiner has merely selectively picked one feature of the Widlund patent and stated that one of ordinary skill in the art would know to add fasteners to the web before cutting the web into individual diapers. As set forth in MPEP §2143, "the teaching or suggestion to make the claimed combination ... must ... be found in the prior art, not in the applicant's disclosure."

6. Paragraph 7 of the Final Office Action Mailed February 24, 2004: Response to Arguments

In the Final Office Action mailed February 24, 2004, the Examiner responds to the remarks made in Applicants' Response submitted on February 4, 2004 with respect to claim 8. The Examiner

Appl. No. 10/026,123

Response dated February 21, 2004

acknowledges that neither the Widlund patent nor the Fletcher application disclose jointly rotating a gripping means. However, the Examiner believes the Office Action mailed November 5, 2003, in paragraph 2, addressed the jointly rotating gripping means as being disclosed by the Schmitz patent. Further, the Examiner believes claim 8 specifically discusses the limitation of a step of folding inward a portion of the longitudinal edge of a waist section, which the Widlund patent discloses.

Applicants continue to believe that the Examiner is relying on impermissible hindsight facilitated by the present application to contend that the combination is obvious. The Examiner does not explain the motivation or suggestion in the Fletcher application that would lead one of skill in the art to combine its disclosure with the disclosure of the Schmitz patent.

7. Paragraph 8 of the Final Office Action Mailed February 24, 2004: Response to Arguments

In the Final Office Action mailed February 24, 2004, the Examiner expresses her belief that it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. The Examiner also believes that so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

In addition to reiterating the arguments made in the Response submitted on February 4, 2004, Applicants offer the following additional remarks in response to the Examiner's final rejection of claims. Applicants continue to believe that there is no suggestion or motivation to combine the particular bits and pieces selected by the Examiner from the Widlund patent, the Fletcher application, the Roessler patent and the Johansson patent with the disclosure of the Schmitz patent. The motivation to modify the Schmitz patent must flow from some teaching in the prior art that suggests the desirability or incentive to make the modification needed to arrive at the invention claimed in the present application. Further, the requisite motivation must come from the prior art, not Applicants' specification. Using Applicants' disclosure as a blueprint to reconstruct the claimed invention from isolated pieces of the Schmitz patent, the Widlund patent, the Fletcher application, the Roessler patent and the Johansson patent contravenes the statutory mandate of section 103 of judging obviousness at the point in time when the invention was made. The Examiner has not indicated why one of ordinary skill in the art would be motivated to combine the prior art. Just because the disclosures of the prior art are capable of being combined, the requisite motivation/suggestion has not been established.

In conclusion, and in view of the remarks set forth above, Applicants respectfully submit that the application and the claims are in condition for allowance and respectfully request favorable

Appl. No. 10/026,123

Response dated February 21, 2004

consideration and the timely allowance of pending claims 1-23. If any additional information is required, the Examiner is invited to contact the undersigned at (920) 721-4558.

The Commissioner is hereby authorized to charge any prosecutorial fees (or credit any overpayment) associated with this communication to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such extension is requested and should also be charged to our Deposit Account.

Respectfully submitted,

CHRISTOPHER P. OLSON ET AL.

By: 

David J. Klann

Registration No.: 46,833

CERTIFICATE OF FACSIMILE TRANSMISSION

I, Barbara D. Miller, hereby certify that on April 21, 2004, this document is being transmitted via facsimile to the Commissioner for Patents via facsimile number 703-872-9306.

By: 

Barbara D. Miller